

REMARKS

Claims 1-79 are pending in the application.

Claims 1, 2, 5, 6, 9-17, 29-34 and 43 are rejected in the Office action under the judicially created doctrine of obviousness-type double patenting in view of commonly owned US patent no. 6,602,202. Claims 16, 17 and 21 are provisionally rejected in the Office action under the judicially created doctrine of obviousness-type double patenting in view of copending application no. 10/834,554. At least in view of the provisional double patenting rejection of claims 16, 17 and 21, the applicants traverse the requirement to provide a terminal disclaimer at least until the provisional obviousness-type double patenting rejection is withdrawn and/or made non-provisional.

The Office action rejects claims 16, 17 and 21 as being anticipated by U.S. Patent 5,916,174 ("Dolphin"). To sustain the finding of anticipation the examiner must demonstrate that each and every limitation of the claims is taught by a single reference. As the Dolphin reference fails to teach or suggest every limitation of claim 16, as amended, Dolphin does not anticipate claims 16, and claims 17 and 21 dependent thereon.

Dolphin discloses an audiometric screening apparatus and method. However, this screening apparatus and method does not include a test signal consisting of a carrier component and a modulation component. Amended claim 16 now clearly distinguishes the test signal and its components over Dolphin.

Accordingly, applicant respectfully submits that Dolphin does not anticipate claims 16, 17, and 21, which are now allowable.

The Office action rejects claims 1, 2, 5 and 6 as being unpatentable over Dolphin in view of U.S. Patent 4,038,496 ("Feezor"). To establish a *prima facie* case of unpatentability the examiner must demonstrate that a single reference or a combination of references teach or suggest each and every limitation of the claims. As Dolphin and Feezor fail to teach or suggest every limitation of claims 1, 2, 5 and 6, as demonstrated below, the proffered combination cannot render the claims unpatentable.

Neither Dolphin nor Feezor teach the use of a test signal having an exponential modulated component. Feezor discloses the use of a voltage programmable oscillator generating pure tone audio signals of selected frequencies in response to pre-selected input voltages. The oscillator input is an exponential ramp voltage which is used to generate the

pre-selected frequencies of the test signal. The invention described in pending claims 1, 2, 5 and 6 has a test signal with an exponential modulated component that directly modulates the test signal. Feezor does not teach or suggest this direct modulation of the test signal but rather it teaches a test signal with pre-selected frequencies. Since Feezor does not disclose an exponential modulated test signal, it would not be obvious for one of ordinary skill in the art to exponentially modulate the test signal of Dolphin.

For at least these reasons, claims 1, 2, 5 and 6 are allowable over the combination of Dolphin in view of Feezor.

The Office action rejects claim 43 as being unpatentable over Dolphin in view of U.S. Patent 4,622,440 ("Slavin"). To sustain the finding of unpatentability the examiner must demonstrate that a single reference or combination of references teach or suggest each and every limitation of the claims. As Dolphin and Slavin fail to teach or suggest every limitation of claim 43, as amended, as the proffered combination does not render claim 43 unpatentable.

Slavin discloses a hearing aid with a programmable filtered frequency response. It does not teach or suggest to one skilled in the art to combine the hearing aid with Dolphin to create a test signal comprised of a carrier component and a modulation component.

Amended claim 43 now clearly distinguishes the present test signal and its components over Dolphin and Slavin.

In view of the above amendment, claim 43 is allowable over the combination of Dolphin in view of Slavin.

New claims 69-79 are based generally upon claims 18-28 as originally filed. None of the cited references teach or described in connection with a method of objectively testing the hearing of a subject creating a stimulus that includes transient components that evoke a steady state response. As such, the applicants submit claims 69-80 are allowable, and such action is respectfully requested.

Claims 29, 32, 33, 35 and 42 where indicated to contain allowable subject matter as presented in the original. These claims are amended to place them in independent form. Thus, the applicants submit these claims are in allowable form, as are dependent claims 30-31, 34, 36-41. Claim 63 is amended to clarify the repeated steps are (a)-(f).

The applicant submits claims 1-43 and 69-80 are now in a condition for allowance, subject to the filing of a terminal disclaimer upon entry of a non-provisional obviousness-type double patenting rejection.

Claims 44-68 were indicated as allowable in the Office action.

In light of the foregoing, the prompt issuance of a notice of allowance or further action is respectfully solicited. Should the examiner have any questions, the examiner is respectfully invited to telephone the undersigned.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300

By: 

Anthony G. Sitko
Registration No.: 36,278
Attorney for Applicants

Date: December 1, 2005